

January 15, 2016

The Honorable William H. Pauley III
 Daniel Patrick Moynihan
 United States Courthouse
 500 Pearl St.
 New York, NY 10007-1312

**Re: *Koninklijke Philips N.V. v. iGuzzini Lighting USA, Ltd., et al.,*
 Civil Action No. 1:15-cv-3979-WHP-FM;
 Unopposed Motion to Compel Production of License Agreements**

Dear Judge Pauley:

Defendants iGuzzini Lighting USA, Ltd., iGuzzini Lighting North America, Inc., and iGuzzini Illuminazione S.p.A. (“iGuzzini”) request the Court’s assistance resolving a discovery issue relating to iGuzzini’s First Set of Requests for Production (the “Requests”). Pursuant to Federal Rule of Civil Procedure 37 and Local Rule 37.2, iGuzzini moves this Court to compel Plaintiffs Koninklijke Philips N.V. and Philips Lighting North America Corporation (collectively “Philips”) to produce 564 license agreements responsive to Request 13, which Philips identified in a list provided to iGuzzini on January 11, 2016. Philips does not oppose the motion with respect to these 564 licenses. Philips has previously produced certain of these 564 license agreements in another suit pursuant to a court order granting a similar unopposed motion to compel production. *See Technical Consumer Prods., Inc. v. U.S. Philips Corp.*, No. 1:12-cv-02546-CAB (N.D. Ohio Nov. 21, 2013). Philips has agreed to produce to iGuzzini the 564 license agreements it identified to iGuzzini (under ATTORNEYS EYES ONLY designation) if the Court grants this unopposed motion. Because those agreements contain confidentiality provisions, that Philips believes preclude it from producing them absent a Court Order, we are seeking such an Order from the Court. A proposed order is attached as Exhibit A.

iGuzzini served Philips its Requests on September 29, 2015, and Philips replied on October 29, 2015 with its Response to iGuzzini’s First Set of Requests for Production (Nos. 1-109) (“Philips’ Response”). In Request 13, iGuzzini asked for documents, including all license agreements, evidencing any relationship between Philips and each prior assignee of each patent asserted in this action. Philips objected to Request 13 “to the extent it calls for the production of documents or information that are subject to the rights of third parties not affiliated with Philips or that are subject to nondisclosure and/or third-party confidentiality obligations” but still promised to “produce relevant non-privileged documents within its possession, custody, or control, if any, that can be located after a reasonable search, responsive to this Request comprising any assignment, royalty, partnership, or license documents for the Asserted Patents between Philips and any prior assignee of the Asserted Patents.” (Ex. B, Philips’ Response, at 16).

iGuzzini raised the issue of Philips producing responsive license agreements in a meet-and-confer with Philips’ counsel on November 24, 2015. To date, there are 622 responsive

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license agreements, all of which require at least a court order to be disclosed to a third party, such as iGuzzini. Of those licenses, 564 require only a court order (“Category 1 licenses”), while the rest of the total of 622 licenses require more than a court order (“Category 2 licenses”). To satisfy a provision in the Category 1 licenses (agreements limiting third-party disclosures to those made pursuant to court order only), Philips proposed that iGuzzini file this uncontested motion to compel production of those license agreements. Philips maintains that “the process of notifying all licensees whose agreements require more than a court order [Category 2 licenses] to produce is overly burdensome” and premature “before knowing the content of the agreements Philips will produce.” (Ex. C at Dec. 30 Lasswell email to King).¹ While iGuzzini believes that all licenses are relevant to issues in this case, to move discovery along at this time,² iGuzzini moves only to compel production of the Category 1 licenses identified by Philips.

For all of those reasons, iGuzzini respectfully requests that this Court order Philips to produce the 564 license agreements responsive to Request 13 which do not require additional permission from the licensees and which Philips identified in a list provided to iGuzzini on January 11, 2016.

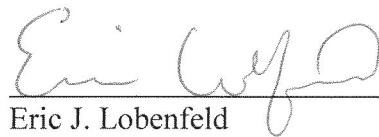
Dated: January 15, 2016

Respectfully submitted,

¹ While the email correspondence between the parties’ counsel refers to “RFP: 14” when discussing the unopposed motion to compel license agreements, the contents of Requests 13 and 14 make clear that the parties meant to refer to Request 13, which specifically mentions license agreements, rather than Request 14, which asks for documents evidencing “communications with third parties regarding the Asserted Patents, the Related Patents, the Related Applications and the Corresponding Applications.” (Ex. B, Philips’ Response, at 16-18.)

² In exchange not to seek a Court Order to produce Category 2 licenses at this time, iGuzzini asked if Philips was willing to approach a dozen of Category 2 licensees to obtain approval to disclose the licenses. Philips countered that it was willing to approach only five and in exchange that iGuzzini refrain from seeking the rest of Category 2 licenses entirely. iGuzzini does not believe that Philips proposal is adequate at this time. However, to lessen the burden on the Court, iGuzzini does not seek Category 2 licenses in this letter-motion and will determine if such licenses are necessary after evaluating the 564 licenses from Category 1. (See Ex. C, at Jan. 11, 2016 Lasswell email to King.)

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CERTIFICATE OF SERVICE

I hereby certify that this document filed through the CM/ECF system will be sent electronically to the registered participants as identified on the NEF (NEF) and paper copies will be sent to those indicated as non-registered participants on January 15, 2016.

Date: January 15, 2016

Respectfully submitted,

/s/ Eric J. Lobenfeld _____

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